

REMARKS

The Official Action of January 7, 2009, made final, has been carefully reviewed. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

The claims have been amended to be directed to the elected invention. For convenience in entry of the amendment, the claims have been canceled in their entirety and presented as new Claims 58-65. The structural formula (I) and formula (II) have been merged together to reflect the current definitions of  $X^1$  is N,  $X^2$  is N,  $X^3$  is CH, and W represents a group of the formula (II). The Claims have been amended to be in proper claim format. Support for this amendment is found in the specification, e.g. at page 9, line 12 to page 10, line 34; and the claims of the application as filed.

Claims 58-65 are pending in the application.

Applicants gratefully acknowledge that the rejection of Claims 35-38 and 45-47 under 35 U.S.C. § 102(c) has been withdrawn.

**Claim Rejections - 35 U.S.C. § 112, First Paragraph**

Claims 48, 49, 51-54 and 56 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement.

The Examiner was concerned regarding the variables within the definition of the variable Y. The Examiner stated: "the specification, while enabling for instances where variable Y is phenyl, O-phenyl, naphthyl, quinoliny, 4-oxo-1,3-diazole, piperidin-2-one, pyridine, pyridin-2-(1H)-one, dialkylamino, pyrimidine, [1,2,4]-triazolo[4,3-a]pyridine, dibenzo[b,d]furan and  $\text{CH}_2$ -piperidiny, does not reasonably provide enablement for the other possible groups disclosed for variable [Y] in these claims.... Applicants have only provided support for compounds where variable [Y] is phenyl, O-phenyl, naphthyl, quinoliny, 4-oxo-1,3-diazole, piperidin-2-one, pyridine, pyridin-2-(1H)-one, dialkylamino, pyrimidine, [1,2,4]-tirazolo[4,3-a]pyridine, dibenzo[b,d]furan and  $\text{CH}_2$ -piperidinyl."

Applicants respectfully assert that the specification fully enables such claims and that the representative examples provide appropriate guidance for practicing the claimed invention without undue experimentation.

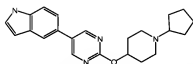
Applicants note that the specification provides detailed guidance regarding the scope of substituents that may be employed at the Y position.

Applicants note that in addition to the substituent groups mentioned above, the Specification describes the preparation of compounds bearing the following definitions for Y:

indolyl	(Example 16, page 78)
piperidinyl	(Example 20, page 79)
thienyl	(Example 31, page 82)
piperazinyl	(Example 47, page 88)
imidazo[1,2,a]pyridine	(Example 57, page 91)

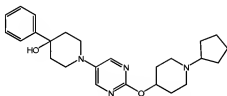
For the convenience of the Examiner, the structures and names of these compounds are provided below:

Example 16:



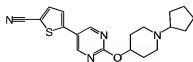
2-(1-cyclopentylpiperidin-4-yloxy)-5-(5-indolyl)pyrimidine

Example 20:



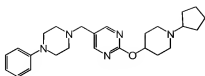
2-(1-cyclopentylpiperidin-4-yloxy)-5-(4-phenyl-4-hydroxypiperidin-1-yl)pyrimidine

Example 31:



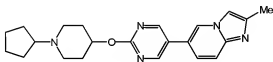
2-(1-cyclopentylpiperidin-4-yloxy)-5-(2-cyano-5-thienyl)pyrimidine

Example 47:



2-(1-cyclopentylpiperidin-4-yloxy)-5-(4-phenylpiperazin-1-ylmethyl)pyrimidine

Example 57:



2-(1-cyclopentylpiperidin-4-yloxy)-5-{2-methylimidazo[1,2,a]pyridin-6-yl}pyrimidine

As demonstrated by the exemplification of such compounds in the Examples, Applicants have provided support not only for compounds bearing Y as "phenyl, O-phenyl, naphthyl, quinolinyl, 4-oxo-1,3-diazole, piperidin-2-one, pyridine, pyridin-2-2(1H)-one, dialkylamino, pyrimidine, [1,2,4]-triazolo[4,3-a]pyridine, dibenzo[b,d]furan and CH<sub>2</sub>-piperidinyl", but also for compounds bearing Y as indolyl, piperidinyl, thienyl, piperazinyl and imidazo[1,2,a]pyridine.

In the interest of compact prosecution, the claims have been amended without prejudice as requested by the Examiner and as noted above.

Accordingly, the rejection of Claims 48, 49, 51-54 and 56 under 35 U.S.C. § 112, first paragraph, for lack of enablement should be withdrawn.

#### **Allowable Claims**

Applicants gratefully acknowledge that Claims 50, 55 and 57 appear free of the prior art of record.

An Information Disclosure Statement is submitted herewith regarding the issuance of a Supplementary European Search Report on February 16, 2009, in the corresponding EPO application. The reference cited therein as WO 97/28128 corresponds to U.S. Patent No. 6,313,127 (to which WO 97/28128 is cumulative). Applicants note the compounds of U.S. Patent No. 6,313,127 are clearly distinguishable from the presently-claimed compounds because they are e.g. 1-pyridyl-4-pyridyloxy-piperidines that are disclosed as inhibitors of the enzyme squalene cyclase. In contrast, the present compounds are pyrimidinyl-oxy-piperidines which do not possess a pyridyl group at the 1-position of the piperidine.

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

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